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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,631	12/08/2000	William D. Brown	23354/49C2	6102

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EXAMINER

ELVE, MARIA ALEXANDRA

ART UNIT

PAPER NUMBER

1725

12

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/733,631

Applicant(s)
Brown et al.

Examiner
M. Alexandra Elve

Art Unit
1725



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/18/02
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-8 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Bessho (US Pat. 4,978,219).

Bessho discloses measuring the roughness of a surface. A reference laser beam and a measuring laser beam, which have different wavelengths are used. The surface roughness is changed (abstract).

3. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Moslehi (US Pat. 5,741,070).

Moslehi discloses a first laser beam having a first wavelength and a second laser beam having a second wavelength. The change in specular reflectance resulting from the modulation of the wavelength of the first and second laser beams is measured Surface roughness is measured (abstract).

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagy (US Pat. 5,504,303).

Nagy discloses an apparatus for the measuring and ablation of diamond surface. The system is comprised of an ablation laser, a profilometer laser, an automatic feedback control unit and electro-mechanical positioning device. A multi-mode laser is used. The unit is used to smooth out any irregularities which may contribute to the diamond sample thickness. The ablation steps are repeated in order to obtain the required surface smoothness (abstract). The same laser may be used for the ablation and measuring or separate laser beams may be used (col. 2, lines 47-49). High and low energy beams may be used. The diamond is affixed to a sample holder (col. 3, lines 20-37). Nagy does not specifically teach evaporation the surface material, although ablation is taught. These are functionally equivalents. Furthermore, intended use has been continuously held not to be germane to determining the patentability of the apparatus, In re Finsterwalder 168 USPQ 530.

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Response to Amendment

6. Upon carefully reviewing Applicant's arguments filed October 18, 2002 the Examiner acknowledges the amendments to claims 6-8. The objections to claims 6 & 8 are withdrawn in view of applicant's amendments. Additionally, applicant is incorrect with respect to the numbering of claims.

7. Applicant's arguments filed October 18, 2002 (paper # 11) have been fully considered but they are not persuasive.

Applicant argues a rejection of claim 5 over Bessho and Moslehi. Claim 5 was not rejected over the above stated prior art. Consequently, applicant's argument is moot.

Applicant argues that a first and second wavelength which modifies a surface is not taught. The examiner respectfully disagrees because a multi-mode laser is used. Furthermore, the same laser may be used for the ablation and measuring or separate laser beams may be used and high and low energy beams may be used.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See US PTO-892.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Alexandra Elve whose telephone number is (703) 308-0092. The examiner can normally be reached Monday to Friday from 6:30 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn, can be reached on (703) 308-3318. The fax number for the group is (703) 872-9310 (non-after finals) and (703) 872-9311 (after finals).

Any inquiry of general nature to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-0661.

December 2, 2002.


M. ALEXANDRA ELVE
PRIMARY EXAMINER